



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,114	06/16/2000	Eddy H. Kimura	6871-106/10002164	1591

27614 7590 06/09/2004
RALPH W. SELITTO, JR.
C/O MCCARTER & ENGLISH, LLP
GATEWAY CENTER FOUR
100 MULBERRY STREET
NEWARK, NJ 07102

EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
----------	--------------

2682

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,114

Applicant(s)

KIMURA ET AL.

Examiner

Eugene Yun

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 12-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 12-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/2004 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 3, 4, and 12-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Wizig (US 6,735,569).

Referring to Claim 12, Wizig teaches a system for providing benefits information to at least one benefits recipient comprising:

at least one portal website (see passage from 110 to 130 in fig. 1);

at least one benefits coordinator computer system communicating with said portal 130 (fig. 1);

at least one benefits recipient system 110 (fig. 1) communicating with said portal website via the Internet 140 (fig. 1); and

at least one benefits vendor computer system 200 (fig. 1) communicating with said at least one benefits coordinator computer system such that benefits information is provided from said at least one benefits vendor computer system to said at least one benefits recipient system via said portal web site (see col. 2, lines 62-67 and col. 3, lines 1-6), said at least one benefits coordinator computer system being a system which is separate from said at least one benefits vendor computer system (see 120 and 130 in fig. 1);

wherein said at least one benefits coordinator computer system selects vendor information from at said least one vendor computer system for delivery to said at least one benefits recipient system based, at least in part upon information stored on said at least one benefits coordinator computer system (see col. 26, lines 63-67 and col. 27, lines 1-2).

Referring to Claim 21, Wizig teaches an Internet based system for delivering benefits information to at least one benefits recipient, said system comprising:

a benefits provider computer system storing employee information 230 (fig. 2);

a benefits coordinator computer system 130 (fig. 1) storing further employee information provided by the benefits recipient; and

a benefits vendor computer system 120 (fig. 1) storing vendor benefits information, said benefits vendor computer system being in communication with said benefits coordinator computer system via the Internet 140 (fig. 1), said benefits coordinator computer system being a system which is separate from said benefits vendor computer system (see 120 and 130 in fig. 1);

said benefits coordinator computer system including a server providing a portal accessible by the benefits recipient (see passage from 110 to 130 in fig. 1), said server being programmed such that benefits information provided to the benefits recipient via said portal web site is selected from said stored vendor benefits information based, at least in part, upon said information stored by said benefits provider computer system, whereby the selected benefits information is communicated from said benefits vendor computer system via said portal to said benefits recipient (see col. 26, lines 60-67 and col. 27, lines 1-2).

Referring to Claim 24, Wizig teaches a method of providing benefits information from an employer to at least one employee benefits recipient, said method comprising the steps of:

providing a computer network connecting an employer server system 200 (fig. 1), a benefits coordinator server system 130 (fig. 1), and a plurality of benefits vendor server systems 120 (fig. 1), said benefits coordinator server system being a system which is a separate from said plurality of benefits vendor server systems (see 120 and 130 of fig. 1);

providing a portal web site 140 (fig. 1) on said coordinator server system, said portal web site being accessible by the employee benefits recipient 110 (fig. 1); and

providing selected vendor benefits information from at least one of said plurality of benefits vendors server systems to the employee benefits recipient via said portal web site, said vendor benefits information being selected based on information stored on said employer server system (see col. 26, lines 64-67 and col. 27, lines 1-2).

Referring to Claim 30, Wizig teaches a system for providing benefits from at least one of a plurality of benefits vendors to at least one benefits recipient, said system comprising:

at least one computer network connecting a benefits provider server system storing information of a first type 230 (fig. 2), a benefits coordinator server system 130 (fig. 1), and a plurality of benefits vendor server systems 120 (fig. 1) storing information of a second type, said benefits coordinator server system being a system which is separate from said plurality of benefits vendor systems (see 120 and 130 in fig. 1);

said benefits coordinator server system including a portal accessible by the benefits recipient (see passage from 110 to 130 in fig. 1);

said benefits coordinator server system being programmed to select information of said second type obtained from at least one of said plurality of vendor server systems based upon information of said first type obtained from said benefits provider server system (see col. 26, lines 63-65), said benefits coordinator server system being programmed to provide said information of said second type to the benefits recipient via said portal (see col. 26, lines 66-67 and col. 27, lines 1-2).

Referring to Claim 3, 19, 20, 22, 23, and 26, Wizig also teaches employment related benefits accessible by the benefits recipients through a wireless PDA (see col. 6, lines 20-22).

Referring to Claim 4, Wizig also teaches said PDA displaying web pages according to the WAP standard (see col. 6, lines 20-24).

Referring to Claim 13, Wizig also teaches said information stored on said at least one benefits coordinator computer system selected from the group consisting of: gender, age, address, personal interests, professional interests, and employment information (see col. 8, lines 32-33).

Referring to Claims 14 and 27, Wizig also teaches said at least one benefits vendor is selected from a group consisting of:

Investment providers, health benefits providers, retirement benefits providers, exercise benefits providers, travel benefits providers, food benefits providers, child care benefits providers, housing benefits providers, and discount goods and services benefits providers (see col. 6, line 25).

Referring to Claims 15, Wizig also teaches at least one benefits provider computer system communicating with said at least one benefits coordinator computer system (see passage from 200 to 130 in fig. 1).

Referring to Claim 16, Wizig also teaches said at least one benefits coordinator computer system programmed to select the vendor information from said at least one vendor computer system for delivery to said at least one benefits recipient system based, at least in part, upon information received by said at least one benefits coordinator computer system from said at least one benefits provider computer system (see col. 6, lines 8-13).

Referring to Claim 17, Wizig also teaches a server included in said at least one benefits coordinator computer system and said at least one benefits vendor computer system and said at least one benefits recipient computers system are client system in communication with said client server system (see connection of all devices in fig. 1).

Referring to Claim 18, Wizig also teaches a thin client system (fig. 4A-4D).

Referring to Claim 25, Wizig also teaches obtaining personal data from said employee benefits recipient via said portal web site (see col. 26, lines 54-56), selecting benefits information from the at least one of said plurality of vendor server systems based on the personal data obtained by carrying out the obtaining step (see col. 26, lines 63-65), and providing the selected vendor benefits information to the employee benefits recipient via said portal web site (see col. 6, lines 66-67 and col. 27, lines 1-2).

Referring to Claim 28, Wizig also teaches providing at least one vendor benefit at a reduced cost based on the number of said employee benefits recipients selectable to receive said at least one vendor benefit (see col. 27, lines 3-21).

Referring to Claim 29, Wizig also teaches offering at least one discount on vendor benefits such that the costs of administering said benefits from said employer to said employee benefits recipient by said benefits coordinator is reduced (see col. 27, lines 3-21).

Referring to Claim 31, Wizig also teaches said information of said second type selected from non traditional benefits information (see col. 6, lines 25-34) and said information of said first type selected from employee data stored on said benefits provider computer system (see col. 7, lines 58-66).

Referring to Claim 32, Wizig also teaches said benefits coordinator server system further programmed to select information of said second type from at least one of said plurality of vendor server systems based, at least in part upon information of a third type provided by the benefits recipient (see col. 8, lines 25-40).

Referring to Claim 33, Wizig also teaches said information of said third type selected from the group consisting of information relating to personal interests of the benefits recipient, information relating to professional interests of the benefits recipient, information relating to life events of the benefits recipient, and information relating to family members of the benefits recipient (see col. 8, lines 36-37).

Referring to Claim 34, Wizig also teaches said non traditional benefits selected from a group consisting of:

Investment providers, health benefits providers, retirement benefits providers, exercise benefits providers, travel benefits providers, food benefits providers, child care benefits providers, housing benefits providers, and discount goods and services benefits providers (see col. 6, line 25) and wherein said employee data is selected from the group consisting of: gender, age, birthdate, length of employment, dependent information, health information (see col. 8, lines 32-33).

Referring to Claim 35, Wizig also teaches said at least one computer network including the Internet 140 (fig. 1).


Response to Arguments

4. Applicant's arguments with respect to claims 3, 4, and 12-35 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eugene Yun
Examiner
Art Unit 2682

EY


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600
6/1/04